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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,746	02/08/2005	Mikio Ikenishi	330-287	4942

23117 7590 09/19/2007
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EXAMINER

FALASCO, LOUIS V

ART UNIT	PAPER NUMBER
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1773

MAIL DATE	DELIVERY MODE
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09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,746	IKENISHI ET AL.	
	Examiner	Art Unit	
	Louis Falasco	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/25/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

PAPERS RECEIVED

1. The Information Disclosure Statement filed 2/8/05; 1/25/06; 10/25/06 and 2/26/07 are acknowledged.
2. The certified priority papers filed 5/17/05 have been received.

CLAIMS

3. The claims are: 1 to 12.

Election/Restriction of Invention

4. Restriction is required under 35 U.S.C. 121 and 372.
 - a. This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claims 1 to 11, drawn to a glass substrate, classified in class 428 subclasses 846.9.

Group II, claim 12, drawn to a method of coating, classified in class 427 subclass 127.

- b. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: (i) the glass of Group I does not require the heat treating and coating steps of by the method of Group II and (ii) the corresponding special technical feature shared by Group I and Group II, an glass substrate, does not define a contribution over the art as event from either **Hashimoto et al** (US 6332338) – see col. 1 ln 65 to col. 2 ln 34 and **Speit** (US 5846280) – see col. 2 lns 32-43.

Election of Species

5. If Group I is elected:

The following patentably distinct species must also be elected from the Group I invention:

- A. Alkali-metal-oxide-containing glass having SiO₂, Al₂O₃, CaO, BaO and K₂O as essential components appearing in claim 2.
- B. Alkali-metal-oxide-containing glass having SiO₂, Al₂O₃, CaO, BaO, K₂O, MgO, SrO, TiO₂, ZrO₂, Li₂O, Na₂O and ZnO as essential components appearing in claims 3 to 6.

- C. The glass of the linear thermal expansion coefficient $70 \times 10^{-7} / ^\circ\text{C}$ or more appearing in claim 7.
 - D. The glass of alkali-metal-oxide-containing has a specific gravity of 3.5 or less appearing in claim 8.
 - E. The glass based storage laminate appearing in claims 9 to 11.
6. Applicants are required under 35 U.S.C. 121 to elect a single species for prosecution on the merits. Currently claim 1 is generic.
7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
8. Applicants are advised that a reply to this requirement must include an identification of the Species and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
9. Should applicant *traverse* on the ground that the Species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the Species to be obvious variants or clearly admit on the record this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35U.S.C. 103(a) of the other invention.

10. Applicant is advised that the reply to this requirement to be complete must include an Election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
11. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

CONCLUSION

12. The claims are to 1 to 12.
 - Information Disclosure Statements and priority papers have been received.
 - Restriction has been required.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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